

**REMARKS**

This amendment is response to the Official Action mailed August 19, 2004. A request for continued examination of this application is enclosed herewith. Claims 1-9 and 28-65 remain pending in this application. Claims 10-27 have been canceled.

The Examiner rejected all of the pending claims, namely, claims 1-9 and 28-65, under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2001/0032187 ("*Nuttall*") in view of U.S. Patent Application Publication No. 2002/0029380 ("*Matsumoto*").<sup>1</sup> In addition, the Examiner rejected claims 2, 3, 32-35, 44-47 and 56-57 under 35 U.S.C. § 103(a) as being unpatentable over *Nuttall* in view of *Matsumoto* and further in view of U.S. Patent No. 6,388,714 ("*Schein*").

Applicant has amended claims 1, 2, 6, 7, 9, 28, 32, 33, 34, 38, 39, 40, 44, 45, 46, 50-56, 60, 61, 64 and 65. Claims 1, 28, 40, 55 and 64 are independent claims. Applicant's amended claims clearly distinguish over *Nuttall*, *Matsumoto* and *Schein*, whether considered individually or in combination.

*Nuttall* discloses a method for distributing digital works among "nodes" of a communications network. As explained in *Nuttall*, each node "includes at least one computer system" connected to the network and preferably "addressed by a node address, for example a uniform resource locator (URL), a name from a domain name system (DNS), or an Internet Protocol address (IP)." (*Nuttall*, ¶ 29, lines 4, 14-17.) As further explained in *Nuttall*, a digital work is requested by one of a plurality of content requesting nodes 110 connected to network 100. (*Nuttall*,

---

<sup>1</sup>The Examiner's contention that *Nuttall* in view of *Matsumoto* anticipates claims 1-9 and 28-65 under 35 U.S.C. § 102(e) is wrong as a matter of law. A combination of references cannot anticipate a claim. Applicant assumes that the Examiner contends that this combination of references renders these claims unpatentable under 35 U.S.C. § 103(a).

Figure 1.) The system for responding to such a request includes a plurality of other nodes, namely, content acquisition node 102, content managing node 104, provider preparation node 106, content providing node 108, authorizing node 112, event reporting node 116, banking node 114 and reconciling node 118. (Nuttall, Figure 1.) Nuttall explains the operation of these nodes as follows:

To request a data transfer in a preferred embodiment for the Internet, a user or consumer at content requesting node 110 uses a network browser, such as Microsoft Internet Explorer, and follows an Internet link (clicks on a portion of an HTML file display), causing a message in HTTP format to be conveyed on line 136 to content providing node 108. Content providing node 108 forwards the request on line 138 to authorizing node 112. If the request is valid, authorizing node 112 creates a permit and sends it on line 146 to content requesting node 110. A permit is a message created to uniquely respond to the request from a particular content requesting node. Using portions of the permit, content requesting node 110 requests on line 136 particular files from content providing node 108. In response, such particular files are conveyed on line 148 to content requesting node 110, completing the data transfer.

(Nuttall, ¶ 34)

Schein discloses a system "for providing television schedule and/or listing information to a viewer, and for allowing the viewer to link, search, select and interact with information in a remote database, e.g., a database on the internet." (Abstract.) Schein discloses no means for storing or managing copyright information.

Matsumoto discloses "an automatic transaction terminal having an IC card for storing electronic money information, age information such as [an] owner's age or date of birth, and other" information. (Matsumoto, ¶ 10.) One such terminal is a decoder for decoding scrambled television signals "of a pay TV broadcasting system." (Matsumoto, ¶ 24.) As shown in FIG. 1 of Matsumoto, decoder 11 comprises tuner 12 which transmits a scrambled television signal to descrambler 13. IC card 19 is plugged into decoder 11 and provides a "scramble key" to descrambler 13. IC card 19 also includes amount approval processor 23, amount information 24, ID information 25 and age information 26. The operation is described as follows:

When the viewer inserts the IC card 19 into the decoder 11 (Step 101), the program menu is displayed on the TV screen (Step 102). Thereafter, when the viewer selects a program to be watched (Step 103), the amount of charge is displayed on the TV screen (Step 104). When the viewer agrees with payment of the charge (Step 105), the amount of balance in the IC card is read (Step 106). Next, whether the amount of charge can be paid from the amount of balance or not is judged by the amount approval processor 23 (Step 107). If payment is impossible, a display of shortage of balance is outputted from the system controller 14 (Step 115) and then the IC card is ejected (Step 113) and the processing ends.

On the other hand, when payment is possible, the age information in the IC card is read next (Step 108). Thereafter, whether the age of the viewer is under age limit of the selected program or not is judged by the system controller 14 (Step 109). If the age is not under age limit, the balance in the IC card is updated

(Step 110) and then the data is decrypted by the descrambler 13 and the scrambling is released (Step 111). If the age is under age limit, an indication that audience is prohibited due to an age limit is displayed on the TV screen (Step 116), and then the IC card is ejected (Step 113), and the processing ends.

(Matsumoto, ¶¶ 37 and 38.)

Matsumoto, therefore, is directed to viewing scrambled television signals, not downloading and storing copyrighted works such as copyrighted musical works. Applicant's invention provides a system for both viewing scrambled television signals and also simultaneously downloading and storing copyrighted works transmitted with the scrambled television signals.

In one embodiment, Applicant's receiving apparatus 4b includes, as shown in FIG. 6, tuner 51, descrambler 52 and transport section 53. An MPEG transport stream containing data packets for television programming multiplexed with data packets for copyrighted musical works is transmitted to tuner 51 via input terminal T1. Descrambler 52 receives the output of tuner 51 and descrambles the multiplexed MPEG data. Transport section 53 receives the output of descrambler 52 and selects the audio and video MPEG packets comprising a selected television program for transmission to MPEG audio decoder 54 and MPEG video decoder 55, respectively. MPEG audio decoder 54 decodes the MPEG audio packets, and MPEG video decoder 55 decodes the MPEG video packets. The output of MPEG audio decoder 54 is transmitted, via digital to analog converter 56 and switch 1, to output terminal T3, and the output of MPEG video decoder 55 is transmitted to output terminal T2 via NTSC converter 57. Output terminals T2 and T3 provide the video and audio signals, respectively, for the selected television program to a television terminal for display and reproduction.

While watching the television program, a user may select for downloading and storage a particular copyrighted musical work presented during the television program. Upon making such a selection, transport section 53 selects from the multiplexed MPEG transport stream the MPEG audio packets comprising the selected copyrighted musical work and transmits these MPEG packets to either MPEG audio decoder 54 or IEEE 1394 interface 60. MPEG audio decoder 54 decodes the MPEG packets and transmits the decoded audio data to output terminal T4, via digital to analog converter 56 and switch 1, or to optical digital output interface 59. Output terminal T4, optical digital output interface 59 and IEEE 1394 interface 60 provide for storage the audio data for the selected copyrighted musical work to a memory connected to these interfaces (see FIGS. 7A-7D).

As amended, claim 1 recites, among other elements: distributing means associated with the distribution facility for distributing the copyrighted works through a given transmission path to the receiving facility, the copyrighted works being distributed to the receiving facility as first digital data packets multiplexed with a video program comprising second digital data packets, the receiving facility comprising a packet selector in communication with a second memory and a monitor, the packet selector receiving the first and second digital data packets and selecting the first digital data packets for transmission to the second memory for storage and selecting the second digital data packets for transmission to the monitor for displaying the video program

Applicant's other independent claims, namely, claims 28, 40, 55 and 64 contain similar limitations. Neither Nuttall,

*Schein* nor *Matsumoto*, whether considered individually or in combination, anticipates or suggests Applicant's invention as recited in these independent claims.

Applicant submits that this amendment and response place this application in condition for allowance. An early notice of allowance of all of the pending claims, namely, claims 1-9 and 28-65, therefore, is respectfully requested. If for any reason the Examiner does not believe that such action can be taken at this time, however, he is respectfully requested to telephone Applicant's attorney at (908) 654-5000 in order to overcome any additional objections he may have.

If any additional charges are due in connection with this requested amendment, the Examiner is authorized to charge Deposit Account 12-1095 therefor.

Dated: October 29, 2004

Respectfully submitted,

By

  
Arnold B. Dompieri

Registration No.: 29,736  
LERNER, DAVID, LITTENBERG,  
KRUMHOLZ & MENTLIK, LLP  
600 South Avenue West  
Westfield, New Jersey 07090  
(908) 654-5000  
Attorney for Applicant